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IN THE

Supreme Court of the United States

OCTOBER TERM, 1976

76-
No. 1559

C. MARSHALL DANN,
COMMISSIONER OF PATENTS AND TRADEMARKS,
Petitioner,
v.
GLEN F. CHATFIELD,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION

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OBJECTION TO JURISDICTION

Petitioner failed to file his petition for writ of certiorari or to move for an extension of time for doing so within ninety days of the entry of judgment by the Court of Customs and Patent Appeals. Therefore, this Court has no jurisdiction to review the judgment of the Court below. 28 U.S.C. §2101(c); *FTC v. Minneapolis-Honeywell Regulator Co.*, 344 U.S. 206 (1952); *Parker v. Illinois*, 333 U.S. 571 (1948); *Toledo Scale Co. v. Computing Scale Co.* 261 U.S. 339 (1923).

The Court of Customs and Patent Appeals (hereinafter "CCPA") issued the opinion below and entered judgment on November 18, 1976 in accordance with its standard practice of issuing opinions and entering judgment on the Thursday after the Reporter has delivered to the Clerk an opinion agreed upon by a majority of the CCPA[1]. On that same day the Clerk made the following

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[1]This procedure is detailed in the *Procedural Handbook, The United States Court of Customs and Patent Appeals* (May 1975).

docket entry: "Reversed, Markey, C.J. Dissenting opinion by Judge Rich with whom Judge Lane joins."

On December 10, 1976, the Clerk as a matter of course issued a mandate to the Commissioner of Patents and Trademarks (Reproduced as App. B of the Petition. Pet. 22A). The mandate, "certified" December 10, 1976, bears the date "November 18, 1976" for the entry of judgment.

The issue of the mandate was in accord with the CCPA's rules in effect during 1976 which read:

> "Rule 6.1 PETITION FOR REHEARING
>
> "A petition for rehearing may be filed within 20 days after entry of judgment. . . . It shall be limited to and state points of law or fact which the petitioner believes the court has overlooked or misapprehended and shall not reargue points already considered by the court. . . ."

> "19. Filing of Opinions
>
> "When an opinion of the court has been agreed upon, the authoring judge sends a copy, along with any dissenting or concurring opinion, to the Reporter, who then supplies copies to the Clerk for filing and distribution. Neither the Reporter nor the Clerk is given advance information on when an opinion is to be handed down. On Thursday of each week throughout the year, the Clerk distributes copies of opinions which have been handed down by the court. If Thursday is a legal holiday, the opinion 'down day' for the week is Wednesday. *The 'down day' is the decision (entry of judgment) date.* Copies of published opinions are sent to counsel, lower tribunals, and selected publishers. Non-published opinions are sent only to counsel and lower tribunals. File copies of opinions can be borrowed from the Clerk's office for reproduction by counsel." [Emphasis Added].

"Rule 6.2 MANDATES

"(a) When Issued. Mandates shall issue to the lower tribunal after 21 days from the date of judgment. The timely filing of a petition for rehearing will stay the mandate until disposition of the petition. If the petition is denied, the mandate shall issue 7 days after denial of the petition. A copy of the opinion or order of the court shall accompany the mandate. . . ."

Rule 6.2 provided mandates shall issue 21 days after the "date of judgment." Rule 6.1 relating to rehearing permitted a petition for rehearing to be filed "within 20 days after entry of judgment." The delay in the issuance of the mandate is to permit a petition for rehearing to be filed prior to the issuance of the mandate. Since the mandate follows the entry of judgment by 22 days, it obviously is not the same thing as the judgment.[2]

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[2]The CCPA revised its rules effective January 1, 1974 for the first time in about 20 years. These revisions were discussed at the court's judicial conference next following the new rules. The comments of the Clerk, George E. Hutchinson on the rules were as follows:

"Mandates: Under Rule 6.2(a) the mandate or final order of the Court is issued on the 22nd day after the *decision or judgment* is rendered. Since decisions are handed down on Thursday, this means that the mandate will issue on a Friday, unless a petition for rehearing is filed under Rule 6.1 or a stay is requested. It should be noted that Rule 6.1 requires that the petition for rehearing be filed within 20 days after date of the *decision or judgment.*" [Emphasis Added]

Proceedings of First Judicial Conference of the Court of Customs and Patent Appeals, April 30, 1974, 65 F.R.D. 171 at 190.

Objection to Jurisdiction.

Since the CCPA entered judgment in the case below on November 18, 1976, the petition for writ of certiorari should have been filed before February 16, 1977. On about March 1, 1977 the Acting Solicitor General applied for an extension of time within which to file a petition. On March 8, 1977 the Chief Justice extended the time for filing the petition until May 9, 1977 without prejudice to the Court's consideration of whether the Commissioner's application was timely filed.

Effective January 1, 1977 the rules of the CCPA were amended. The purpose of the amendments were explained at the Court's next judicial conference. The comments of the Clerk, George E. Hutchinson, were as follows:

> "V. The former rules provided that a petition for rehearing could be filed within 20 days after 'entry of judgment.' At the same time the mandate rule stated that the mandate would issue after 21 days from the 'date of judgment.' As you can see, this created a hiatus of one day. The new rules solved this problem and now provide that a petition for rehearing may be filed within 21 days from the 'date of decision.' You may have caught the change in language between 'entry of judgment' and 'date of decision' in connection with this rehearing rule. I did this on purpose to emphasize the fact that there was a language change in this rule and the rule concerning mandates. Both rules now use the term 'date of decision' rather than 'entry or date of judgment.' *This was not a substantive change but one only of language* to emphasize the fact that time periods for either a petition for rehearing or the issuance of a mandate are from the actual date of the decision or, to state another way, the issuance of the court's opinion. " [Emphasis Added]

Proceedings of the Fourth Judicial Conference of the Court of Customs and Patent Appeals, May 17, 1977 (not yet published).

Objection to Jurisdiction.

The petitioner's argument (Pet. 2 and 3, n. 2) is that the only judgment "issued" by the CCPA is its mandate. Hence, petitioner urges the ninety days within which to file commenced on December 10, 1976. The petitioner further urges that the CCPA's rules in effect in 1976 were "inconsistent with the court's actual practice" relying on *Commissioner v. Estate of Bedford,* 325 U.S. 283, 284-288 (1945).

A "judgment" of an appellate court is its decision (not necessarily opinion) relating to the action of the lower court. "The judgment of a court is the judicial determination of the court upon a matter within its jurisdiction. No form of words and no peculiar formal act is necessary to evidence its rendition or to mature the right of appeal." *United States v. Hark,* 320 U.S. 531, 534 (1944).

The appropriate decisions or judgments of any federal appellate court are to "affirm, modify, vacate, set aside or reverse." 28 U.S.C. §2106. The docket entry in the CCPA on November 18, 1976 was "Reversed." The majority opinion of the lower court ended with the word "Reversed." Either or both of these entries comprise an appropriate entry of judgment. There is, of course, no need for the judgment to "issue." 28 U.S.C. §2101(c). Nevertheless, the opinion bearing the word "Reversed" was published according to the standard procedure of the CCPA (n. 1, *supra*).

A "mandate" is the command of an appellate court to the court below to execute the appellate judgment. It transfers jurisdiction back to the court below. It is the judgment *submitted* to the lower court. *West v. Brashear,* 39 U.S. 51, 54 (1840).

Objection to Jurisdiction.

It is standard appellate practice to enter judgment but delay issuance of the mandate until time for a request for rehearing has elapsed. This gives the court the opportunity to revise its judgment before transmitting it to the lower court. (See Rule 59 of this Court and Rules 36 and 41 of the Federal Rules of Appellate Procedure). The CCPA follows this standard appellate practice. The practice of the CCPA has been documented by correspondence with the Clerk reproduced herein as Appendices A and B.

Petitioner has introduced no evidence that the CCPA follows the unusual practice of treating the "order of mandate" as the judgment. He points to one instance in which the CCPA, when reversed, issued a new mandate without first withdrawing its decision or judgment. There is, of course, no compelling need to do so as the mandate in that instance simply passes on the controlling judgment of the higher court.

The petition having been filed out of time, this court is without jurisdiction to issue a writ of certiorari in this case.

QUESTION PRESENTED

Is the appellant's claimed process (operating a computing system including a general purpose digital computer and its associated peripheral resources concurrently upon a plurality of processing programs to increase thruput) a process within the meaning of the patent statute (35 U.S.C. §101)?

STATUTORY PROVISIONS INVOLVED

35 U.S.C. §100 provides:

> "When used in this title unless the context otherwise indicates—
>
> * * * * *
>
> "(b) The term 'process' means process, art or method, and includes a new use of a known . . . machine, ..."

35 U.S.C. §101 provides:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

28 U.S.C. §2101(c) provides:

> "(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

Statutory Provisions Involved.

28 U.S.C. §2106 provides:

> "The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances."

35 U.S.C. §141 provides:

> "An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, ..."

35 U.S.C. §142 provides:

> "When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints."

35 U.S.C. §144 provides:

> "The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

STATEMENT OF THE CASE

The petitioner's "Statement of the Case" is riddled with misstatements and misunderstandings regarding the nature of Mr. Chatfield's invention and the scope of his claims. Hence, it is necessary for the respondent to restate the case.

Mr. Chatfield's patent application claims a method of operating a computing system (R. 118-124). It does not claim a computer program.[3] Nor does it claim "a process for programming." In practice, however, the method may be at least in part implemented with the aid of a computer program (software). The method enables a computing system to more efficiently execute

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[3]A "computer program" is a listing of every one of the instructions that is required for a computer to complete a sequence of operations or computations. For the program to be processed, it must be in machine language (binary ones and zeros) and along with any binary data upon which the program operates must be loaded into the main memory of the central processing unit of the computing system. The computer is wired to sequentially respond to each of the coded instructions in the program. For example, a machine language coded instruction 00110010 might instruct the central processing unit to perform a load operation. This instruction would be to fetch data from a specific memory location and place it in a particular temporary storage location. Programs are usually not initially written in machine language code but in "high level symbolic languages" such as BASIC, COBOL, FORTRAN or PL/1. The high level symbolic languages are converted by a compiler program to a machine language listing suitable for computer processing. One statement in high level language may be equivalent to many machine language statements. The claims in the Chatfield patent application are neither in machine language (binary ones or zeros) or in symbolic language.

the processing programs upon which the computing system operates.

Mr. Chatfield is the President and part owner of Duquesne Systems Inc., a small Pennsylvania corporation to which he has assigned his patent application. Duquesne Systems Inc. has always had less than about six employees including Mr. Chatfield and its principal business has been to market Mr. Chatfield's computer system operating methods called Qualitative Computer Management (QCM) (R. 18). At present there are over 50 computing systems in the country which use the methods claimed in Mr. Chatfield's patent application. Each user has a paid-up or continuing royalty obligation. Most, if not all, users purchase the use of Mr. Chatfield's method after a trial period in which the method sells itself. The use of Mr. Chatfield's method often permits the users to forego purchase of additional equipment. Hence, Duquesne Systems Inc. competes with manufacturers of computer equipment (hardware) for the computer systems users' dollars.

Modern computing systems operate upon more than one processing program at one time. In fact, computing systems typically operate upon a plurality of processing programs. This technique is known as multiprogramming (R. 6). The processing programs are guided or directed through the computing system by an operating or supervisory portion of the computing system. Respondent's invention relates to certain resource supervising portions of the operating portion of the computing system. More particularly, respondent's invention relates to a method of controlling access priorities or preventing access altogether for the processing programs (R. 9-10). The precise meaning of "priorities" as used in

respondent's application is set forth (R. 14-15) with reference to Figs. 3a and 3b (R. 55).[4]

A computing system comprises one or more central processing unit resources and at least one (but usually many (peripheral resources capable of functioning in parallel with the central processing unit (CPU) (R. 12-13, and especially Fig. 1, R. 51). The CPU comprises associated logic and main memory functions. The CPU

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[4]The petitioner's brief is flawed through and through by confusing the concepts of "allocation" and "priority." The word "allocation" and its associated concept used throughout the petition are foreign to respondent's patent application. For this reason, the petitioner's police officer at an intersection analogies are simply not apt. The police officer standing at an intersection (is this a plurality of resources?) *allots* time to the traffic on one street (a processing program?) and then to traffic on the other. (Compare Pet. 6, n. 6). If the officer knows from experience which street carries the most traffic during a particular time of day, he can adjust the percentage of intersection time allocated to traffic on each street to minimize back-up's. Police officers do not assign priorities except, perhaps, when all traffic is halted (given low priority) to permit an ambulance (given the highest priority) to run through the intersection. Here, however, back-ups are not minimized but created. Also, if the officer allocates time he does so directly proportional to need and not on an inverse need basis. (Compare Pet. 8, n. 8).

Besides the basic error of confusing time allocation and priority, the intersection analogy fails to deal with multiple resources (multiple intersections?) which are basic to respondent's claimed method.

The petitioner's attempts to find a demeaning analogy to the respondent's method just does not work. Furthermore, analogies are unnecessary here. The Court can read and understand the respondent's claims as written.

is that portion of the system that does the actual computation of which a computer is capable. The peripheral units generally input-output or I/O devices are in some way subordinate to the central processing unit. Card readers, printers, tape drives, disc drives, channels, controllers, special and general purpose computers may all be peripheral units. The peripheral resources are of two types: degradable and nondegradable. A degradable resource is one that when shared between two or more programs incurs a significant amount of wasted time switching from one program to the other (R. 13-14).

Prior to multi-programming, computing systems processed programs on a one-at-a-time basis. If a program did not require all resources of the computing system, the unused resources were forced to remain idle for the duration of that particular program. In multi-programming, an *attempt* is made to utilize as many of the computing system resources as possible during all periods of operation (R. 6-9).

According to respondent's claimed method, system utilization data is first accumulated for processing programs for selected resources during an operating interval. System utilization data can comprise resource activity and/or resource degradation data (R. 14). Degradation is the inefficiency that may result when more than one program is competing for the same resource. At spaced intervals, the operation of the computer upon the processing programs is stopped and the accumulated system utilization data is analyzed. Based on this analysis, resource access is regulated during the next period of operation upon the processing programs by assigning individual resource access priorities and/or preventing resource access altogether. (The various

ways in which access priorities can be assigned are discussed hereafter). Operation of the computing system upon the processing programs is then resumed for another operating interval during which system utilization data is again accumulated. In this way, the regulation of resource access is dynamic. It takes place while the computer executes its processing programs. Even though valuable central process unit time as well as central process unit memory space is taken by the program implementing respondent's invention, there is a net gain of efficiency for the overall computing system.

In effect, the computing system operated according to respondent's method continually restructures its mode of operation to accommodate the particular portions of the processing programs then being operated upon. In this way, the claimed method and the computing system synergize.

Respondent's application sets forth five "Embodiments," each directed to a different step for assigning access priorities. Under the heading "EMBODIMENT I" (R. 23-29) respondent discloses two important features of his invention with regard to one specific regulating step. This regulating step requires a minimum amount of CPU time. First, respondent discloses assigning CPU and peripheral access priorities favoring the more "overlapped" processing programs (i.e., those having a more balanced usage of resources) and giving the highest CPU priority to the peripheral bound programs. The peripheral access priorities are assigned inversely to the CPU priorities. This, unlike assignment of priorities for the same program to different

resources, is ignored in the Petition.[5] Second, under the same heading respondent discloses collecting degradation data in addition to resource activity and regulating access priorities to minimize degradation. The elimination of degradation is nowhere mentioned in the Petition. Claims 2 and 3 (R. 118-119) are both specifically directed to regulating by favoring the more overlapped programs as explained in the specification. Claim 3 sets forth an algorithm useful in assigning access priorities. Claims 4 and 5 (R. 119-120) are specifically directed to degradation analysis and regulating access to minimize degradation. Claim 5 includes an algorithm for calculating a productivity factor so that one of the computing programs can be assigned the degradation resulting from the joint competition of the programs for a single resource.

Under the heading "EMBODIMENT II" (R. 29-31) respondent discloses regulating access by assigning separate inverse need access priorities for each processing program to each resource. This type of pure inverse need resource access priority substantially reduces the chance that a processing program will be unable to execute because of a nominal need for service from a saturated resource. The resource most likely to be saturated is the CPU simply because CPU capacity is the most expensive to provide. Claims 6, 15 and 16 (R. 120, 123, 124) are all specifically directed to inverse need priority assignment. Claims 15 and 16 set forth different algorithms for assigning inverse need priorities.

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[5]The Petition characterizes Claim 3 (Pet. 7, n. 7) totally ignoring the claim language "all peripheral resource access priorities are assigned inversely to CPU priorities." (See Claim 3, R. 119.)

Under the heading "EMBODIMENT III" (R. 31-36) respondent discloses assigning priorities using a dynamic linear programming model to maximize the total system's resource utilization by selecting a subset of programs to be executed. This step is very effective where a large number of programs compete for a limited number of resources. Claims 10 and 11 (R. 121) are both directed to these regulating steps. Claim 10 sets forth the general linear function to be maximized. While general linear programming techniques are known, the construction of the productivity factors and the solution of the subsets in a manner to permit or not permit programs to process is unique.

Under the heading "EMBODIMENT IV" respondent describes resource access assignment to improve "program turnaround," i.e., the time any one program takes to process. This regulating step is quite involved but includes degradation analysis and different resource access assignment in succeeding processing intervals favoring first one and then the other of two competing programs which are causing resource degradation. Claim 12 is directed specifically to turnaround techniques.

Under the heading "EMBODIMENT V" (R. 40-43) respondent describes balancing the thruput and turnaround characteristics of the computing systems by varying the ratio of thruput and turnaround operating intervals. These techniques are claimed in Claim 13 (R. 122).

The independent Claims 1, 9 and 14 relate to all of the disclosed embodiments.

ARGUMENT

I.

Certiorari should be denied because petitioner failed to file a timely petition, thus depriving this Court of jurisdiction. The point has been covered under the heading "Objections to Jurisdiction."

II.

Petitioner is attempting to raise issues for the first time before this Court for which no suitable record exists. Hence, certiorari should be denied or limited to the sole issue in respondent's brief. (*supra*, p. 7).

Where issues are neither raised before nor considered by the lower appellate court, this Court will ordinarily not consider them. This Court seeks not to decide questions of great moment without a full and adequate record.[6] As stated in *Singleton v. Wulff*, 428 U.S. 106 (1975) at page 120:

> "It is the general rule, of course, that a federal appellate court does not consider an issue not passed upon below. In *Hormel v. Helvering*, 312 U.S. 552, 556 (1941), the Court explained that this is 'essential in order that parties may have the opportunity to offer all the evidence they believe relevant to the issues . . . [and] in order that the liti-

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[6] *Duignan v. United States*, 274 U.S. 195, 200 (1927); *Husty v. United States*, 282 U.S. 694, 701-702 (1931); *Lawn v. United States*, 355 U.S. 339, 362-363, n. 16 (1958); *Adickes v. Kress & Co.*, 398 U.S. 144, 147, n. 2 (1970); *Ramsey v. Mine Workers*, 401 U.S. 302 (1971); and *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 163-164 (1975); *United States v. Ortiz*, 422 U.S. 891, 898 (1975).

> gants may not be surprised on appeal by final decision there of issues upon which they have had no opportunity to introduce evidence.' "

Every federal appellate court's jurisdiction is limited to review of the judgment or decree made in the lower court or tribunal. 28 U.S.C. §2106. The review of the CCPA in appeals from the Patent and Trademark Office (hereafter PTO) is narrowly framed by provisions of patent statute. 35 U.S.C. §§141, 142 and 144. Hence, the issues before the CCPA necessarily were limited to those set forth in the respondent's Reasons for Appeal (R. 117). This Court has refused to consider rulings where "they were not assigned as error on appeal to the Court of Appeals, and it [did] not appear that they were presented or passed upon there": *Husty v. United States, supra.* Hence, not only as a matter of good appellate practice but as a matter of jurisdiction, this Court should not consider issues not before the PTO Board of Appeals and the CCPA.

The issue before the PTO Board of Appeals was stated as follows (R. 113):

> "Claims 1 through 6, and 9 through 16 stand rejected under 35 USC 101; 'as directed towards non-statutory subject matter'. The basis for the examiner's decision in Gottschalk v. Benson and in In re Christensen, a later decision of the Court of Customs and Patent Appeals."

The majority opinion of the CCPA noted (Pet. 4A-5A)

> "The board took the position that the claims are drawn to non-statutory subject matter under the Supreme Court's decision in *Gottschalk v. Benson* . . . ."

Noting that Mr. Chatfield's claims were not simply directed to computer processing programs, the majority opinion states (Pet. 6A):

> "Thus the issue is not whether a computer processing program, claimed in method terms, is statutory subject matter under 35 U.S.C. § 101."

The CCPA noted no other issue and specifically stated (Pet. 2A):

> "Chatfield's novel solution dynamically evaluates and reassigns program priorities as the programs execute. No prior art was cited against the appealed claims and, accordingly, Chatfield's invention must be considered to have been new and unobvious."

The petitioner for the first time on petition for writ of certiorari seeks to introduce the issues of novelty and unobviousness (Pet. 3-4, 18-22). The record is simply inadequate for resolving these important issues and moreover, even if the record were adequate these issues were not before either the PTO Board of Appeals or the CCPA. While the Patent Examiner cited five prior art patents as being "relevant to the case" (R. 92-98), no rejection of the claims was based thereon. Further, the Examiner made no rejection based upon the respondent's admitted state of the art set forth in the patent application (R. 6-9). If an unobviousness or novelty issue had been raised by the Patent Examiner, the patent applicant (respondent) would have had an opportunity to present to the PTO additional evidence under its appropriate rules. 37 C.F.R. §1.131 and 1.132. Further, the petitioner's reliance now upon *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976) is inconsistent with the findings of the PTO Board of Appeals which found on the record before it that "even though valuable control processing time, as

well as central processing memory space is taken by the regulating program of the invention, there is allegedly a net gain in efficiency for the overall computing system" (R. 114). Clearly, the whole exceeds the sum of the parts.

The petitioner seeks to introduce the novelty and unobviousness issue point blank. (See Pet. 20). The petitioner also seeks to introduce the issue by an attempted intertwining with the statutory subject matter issue. It is asserted that even if respondent's method is "distinguishably less abstract than Benson" there exists "a second and further criterion" to be met (Pet. 19). This supposed "criterion" throws upon respondent the burden of showing that once be possessed his idea, however unobvious and ingenious, the implementation of the idea must be beyond "the routine, conventional or unobvious." This statement of the law is not supported by the principle of nature cases cited in petitioner's footnote 27 (Pet. 19). It is also contrary to the clear reading of the patent statute which recognizes that inventions often take place in two steps; that is, "conception" and "reduction to practice" (35 U.S.C. §102(g)). The statute also provides unobviousness may also be found in the "subject matter as a whole" and "patentability shall not be negative by the manner in which the invention was made" (35 U.S.C. §103). Nevertheless, given the opportunity in a forum charged with fact determinations, respondent would demonstrate that the implementation of his methods is indeed beyond the "routine, conventional or unobvious."

For the reasons the petitioner is attempting to raise novelty and unobviousness issues for the first time in this case before this Court, the petition for writ of certiorari should be denied.

Argument.

III.

The usual reasons for granting certiorari are absent: The CCPA's decision is not in conflict with the prior decisions of this Court or other federal courts of appeals.

The majority opinion of the CCPA correctly interprets 35 U.S.C. §101 in light of this Court's decisions in *Gottschalk v. Benson,* 409, U.S. 63 (1972), and *Dann v. Johnston,* 425 U.S. 219 (1976). Chief Judge Markey's carefully reasoned majority opinion found that the "fundamental rationale" in *Benson* was "that a patent containing Benson's claims would have preempted all practical use of both the underlying mathematical formula and the involved algorithm" (Pet. 7A). It found a "unanimous characterization of the holding in *Benson* "limited" in *Dann v. Johnston* . . ." (Pet. 9A). It found that Chatfield's independent claims (actually most of the dependent claims also) contained no mathematical formula or algorithm (Pet. 14A). The majority also concluded: "The dependent claims [reciting formulas] are not, of course, claims to the mathematical algorithms appearing therein but are claims to the method of independent claims in which the analysis steps are carried out by the use of the specific algorithm. A patent issuing on Chatfield's claimed method would thus preempt neither the mathematical formula nor the algorithms. . . ." The majority found "no basis for treating methods of operating computing machine systems differently from methods of operating any other form of machine system."

In the dissenting opinion below, the issue is posed as follows: "Are programs for general purpose digital computers patentable subject matter under 35 U.S.C. §101?" From this wrong statement of the issue, a nega-

tive conclusion is reached. Respondent herein simply does not claim a computer program or a method for programming a computer.

A recent unanimous decision of the CCPA follows closely the Chatfield decision below (*In re Deutsch*, 193 U.S.P.Q. 645 decided 5/5/77). In *Deutsch*, the claimed method of operating a system of multi-unit plants (e.g., oil refineries) was found patentable. The unanimous opinion of the CCPA stated: "Though ably argued by the Solicitor, the questions of whether the programs fed to the computer described in Deutch's specification are 'processing' programs, and whether programs are themselves patentable, are thus not relevant on this appeal." It would appear that the full court below has now come to the realization that claims to methods which may be implemented at least in part by computer software are not claims to the computer programs themselves.

CONCLUSION

For the above stated reasons, the Petition should be denied.

Respectfully submitted,

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515 Oliver Building
Pittsburgh, Pennsylvania 15222

Attorney for Respondent

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Of Counsel

APPENDIX A

Bell Telephone Laboratories
600 Mountain Avenue
Murray Hill, NJ 07974

June 7, 1977

MR. GEORGE E. HUTCHINSON, Clerk
United States Court of Customs
and Patent Appeals
717 Madison Place NW.
Washington, D.C. 20439

Dear Mr. Hutchinson:

As you may recall from our recent conversation, the Solicitor General has, in the Petition for a Writ of Certiorari in *Noll* and *Chatfield,* raised some questions of actual practice before the Court of Customs and Patent Appeals in respect of "judgments" and how they differ, if at all, from "decisions" or "mandates."

We have requested and received an extension of time to file our Brief in Opposition so that we might obtain additional evidence of actual practice before the Court of Customs and Patent Appeals. We think it would be most enlightening for the Supreme Court if you could provide the parties with a written statement based on your long experienece with the Court treating the important questions raised by the Solicitor General.

It might be helpful to consider the questions listed in Attachment A in any response you might make, but please feel free to be guided by your experience and perception of the issue posed by the facts at hand.

Appendix A.

I've spoken to counsel for Chatfield and Mr. Shapiro in the Solicitor General's office about this letter and have, as indicated, sent copies to them. It would be appreciated if copies of any response you may wish to make could be sent to them as well.

Attached to this letter as Attachment B are what purport to be your remarks at the CCPA's recent Fourth Judicial Conference. Since they treat, in part, the present subject matter, I've included them for convenience of reference for the parties.

Very truly yours,

ORIGINAL SIGNED BY
WILLIAM RYAN
WILLIAM RYAN

.:sv
Atts.

Copy to:
David Hanson
Webb, Burden, Robinson & Webb

Wade H. McCree, Solicitor General
Department of Justice

Appendix A.

ATTACHMENT A

1. What is the function of the "mandate" treated in the Court's Rule 6.2? That is, is it a judgment, or merely an announcement or certification to the Patent and Trademark Office of a prior judgment?

2. What was being referred to in Rule 6.1, as it was worded prior to the change effective January 1, 1977, by the language "20 days after entry of judgment." Was this reference to the time after decision and prior to the issuing of a mandate during which a petitioner could seek rehearing?

3. What was the purpose or intent in amending Rules 6.1 and 6.2 effective January 1, 1977? Do your remarks presented at the Fourth Judicial Conference and appearing in Attachment B hereto accurately reflect this purpose or intent?

4. When inquiries, if any, have been made of you in the past regarding the date from which the period during which a petition for a writ of certiorari to review a C.C.P.A. judgment might be filed in the U.S. Supreme Court begins to run, what date was given to those inquiring? That is, did you advise those inquiring that the 90-day period was measured from the decision date or from the date the mandate issued?

5. Referring to the attached copy of C.C.P.A. docket sheet No. 6942, what meaning was and is attributed to the entry dated February 16, 1967 which recites "Affirmed, Kirkpatrick, Senior Judge?" Was this language used uniformly (except for "Reversed" being substituted, as appropriate) to indicate some act by the Court? How, if at all, did this act relate to the

judgment of the Court? What did the entry dated May 13, 1967 indicate?

6. Referring to the attached copy of C.C.P.A. docket sheet for Docket No. 75-573, what meaning was and is attached to the entries dated November 13, 1975 and December 5, 1975? What significance, if any, can be attached to the difference in the language "FINAL ORDER" in the last entry in Docket No. 6942 and "FINAL MANDATE" in the last entry in Docket No. 75-573?

7. Has the practice in "returning to the Commissioner a certificate of its proceedings and decision" as required by 35 U.S.C. 144 changed at all from May 13, 1967 to the present? If so, did this change in practice involve more than a change in name for the "certificate?"

8. Aside from making uniform the 21-day periods in Rules 6.1 and 6.2, have the changes in language in these Rules which became effective January 1, 1977 caused any change in practice in the Court?

9. In the mandate that issued in *Noll*, e.g., what did the date November 18, 1976 refer to? Was it the date that "This Cause having been heard and considered, it is Ordered and Adjudged: Reversed?" What did the mandate certify on the 10th day of December 1976? What was the "true copy" that was "certified" a copy of?

APPENDIX B

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
717 Madison Place N.W.
Washington, D.C. 20439

June 14, 1977

George E. Hutchinson
Clerk
Telephone: 347-1552
Area Code 202

William Ryan, Esq.
Bell Telephone Laboratories
600 Mountain Avenue
Murray Hill, NJ 07974

Dear Mr. Ryan:

In response to your letter of June 7, 1977, I will answer your inquiries in the order presented.

(1) The basic function of the mandate is to transfer jurisdiction of a case to the lower tribunal. This paper, accompanied by a certified copy of the court's opinion, is transmitted on the 22nd day after issuance of the decision or judgment, or 7 days after denial of a petition for rehearing. It has been our practice to consider the judgment as the decision of the Court and, therefore, part of the opinion. Accordingly, we have not issued a separate judgment paper. Rule 6.2, which was adopted on January 1, 1974, was patterned after Rule 41 of the Federal Rules of Appellate Procedure.

(2) The language in Rule 6.1, prior to January 1, 1977, "20 days after entry of judgment" was a refer-

ence to the time period after the decision in which a petition for rehearing would have to be filed. Again, it was the same language as used in FRAP Rule 41 except for the number of days. If no petition for rehearing was filed, the mandate would issue under Rule 6.2 "after 21 days from the date of judgment."

(3) As was stated in my remarks prepared for the Fourth Judicial Conference, the changes in Rules 6.1 and 6.2 were of language and not of substance. The sole intent was to emphasize that time periods for either a petition for rehearing or the issuance of a mandate are from the actual date of the decision. Reference may be made to our Procedural Handbook of May 1975, No. 19, *Filing of Opinions,* where we state that "the 'down day' is the decision (entry of judgment) date." Also, my remarks concerning mandates at the First Judicial Conference on April 30, 1974, following adoption of the new rules, contains this statement:

> "Under Rule 6.2(a) the mandate or final order of the Court is issued on the 22nd day after the decision or judgment is rendered. Since decisions are handed down on Thursday, this means that the mandate will issue on a Friday, unless a petition for rehearing is filed under Rule 6.1 or a stay is requested. It should be noted that Rule 6.1 requires that the petition for rehearing be filed within 20 days after date of the decision or judgment."
> [65 F.R.D. 190]

(4) It has been the practice of this office to state that the time for filing the petition is 90 days from the date of our decision (judgment); if a petition for rehearing is filed, it is 90 days from the date the petition is denied. See 28 USC 2101(c).

(5) The docket sheet for Patent Appeal 6942 shows that the entry on February 16, 1967, was the court's decision in this case. The language was uniform until 1974 and stated the judgment of the court. The entry on May 13, 1967 was the date on which the final order (now "mandate") was issued to the Commissioner of Patents in compliance with 35 USC 144, a petition for rehearing having been denied in the case on May 4, 1967.

(6) The docket sheet for Appeal 75-573 shows that the decision of the court was rendered on November 13, 1975, and the mandate was issued on December 5, 1975. No significance can be attached to the change of "order" to "mandate", which was done to conform with language of the new rule effective January 1, 1974. Prior to 1974, the only use of "mandate" was in connection with cases from the U.S. Customs Court.

(7) The practice has not changed from May 13, 1967. The sole change has been the 1974 substitution of "mandate" for "order" as the designation of the "certificate" required by 35 USC 144. "Order" was used from 1929 to 1974.

(8) No. The amendments effective January 1, 1977, removed a hiatus period of one day in time for the filing a petition for rehearing under Rule 6.1. The prior rules provided that a petition for rehearing had to be filed within *20* days from the decision date with the mandate to issue "after *21* days." The petition may now be filed within 21 days from the date of decision.

(9) "November 18, 1976" referred to the date of the court's decision (judgment). The mandate of the court, which also includes the words "ordered and adjudged" that the decision of the Board of Appeals be

reversed, was issued on December 10, 1976. Attached to this paper was a certified copy of the court's opinion, which was issued with the decision on November 18th.

Very truly yours,

GEORGE E. HUTCHINSON

GEH:df

cc: David Hanson, Esq.
Webb, Burden, Robinson & Webb

Howard E. Shapiro, Esq.
Office of the Solicitor General